

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Paper No. 14
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Matsushita Electric Corporation of America

Serial No. 76/021,398

Morton Amster and Holly Pekowsky of Amster, Rothstein & Ebenstein
for Matsushita Electric Corporation of America.

LaVerne T. Thompson, Trademark Examining Attorney, Law Office 116
(Meryl Hershkowitz, Managing Attorney).

Before Hohein, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Matsushita Electric Corporation of America has filed an
application to register the term "PALM LINK" for "two-way
radios."¹

Registration has been finally refused under Section
2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis
that, when used in connection with applicant's goods, the term
"PALM LINK" is merely descriptive of them.

¹ Ser. No. 76/021,398, filed on April 10, 2000, based upon an
allegation of a bona fide intention to use such term in commerce.
Applicant subsequently amended the application to set forth May 27,
2000 as the date of first use anywhere and in commerce of such term.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, contrary to applicant's erroneous contention,² whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought,³ the context in which it is being

² Specifically, applicant contends in its reply brief that the assertion by the Examining Attorney in her brief that, in determining mere descriptiveness, a mark must be considered in relation to the identified goods "is contrary to the Federal Circuit's mandate," citing as authority for its contention In re Hutchinson Technology Inc., 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988) and In re DC Comics, Inc., 689 F.2d 1042, 215 USPQ 394, 396 (CCPA 1982).

³ See, e.g., In re Gyulay, supra at 1010 [appellant's reliance on the statement in In re DC Comics, Inc., supra, that a "descriptive term 'conveys to one who is unfamiliar with the product its functions or qualities' ... does not aid appellant's argument that a purchaser of APPLE PIE potpourri would not know that 'apple pie' refers to the scent"]; In re Abcor Development Corp., supra at 218 ["[a]ppellant's proposed abstract test is deficient ... in failing to require consideration of its mark 'when applied to the goods' as required by

used or is intended to be used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of such use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., In re Abcor Development Corp., supra at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., In re Atavio, 25 USPQ2d 1361, 1362 (TTAB 1992) and In re TMS Corp. of the Americas, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

the statute"]; and In re Allen Electric & Equipment Co., 458 F.2d 1404, 173 USPQ 689, 690 (CCPA 1972) ["trademark cases must be decided on the basis of the identification of the goods as set forth in the application"].

The Examining Attorney insists that the term "PALM LINK" is merely descriptive of a characteristic, function, feature, purpose or use of applicant's two-way radios. Notably, however, she fails to specify what such aspect of applicant's goods is, asserting instead the general observations that:

The applicant's mark is a composite mark, where each term [thereof] is descriptive of a characteristic, function, feature, purpose or use of the applicant's goods. The combination ... does not change the overall descriptiveness of the mark. There is nothing incongruous or distinctive about the combination of these terms as related to the goods. A combination of terms, each of which is merely descriptive of a characteristic or feature of a product or service, is also merely descriptive. *In re Serv-A-Portion, Inc.*, 1 USPQ2d 1915, 1916 (TTAB 1986).

As support for her position that the terms "palm" and "link" are merely descriptive of applicant's goods and that the combination thereof is also merely descriptive of such goods, the Examining Attorney relies upon various dictionary definitions⁴ and excerpts from her searches of the "NEXIS" database. Specifically, the Examining Attorney maintains that the word "palm" is merely descriptive of two-way radios because "applicant's goods are palm sized radios," noting that The

⁴ Although other dictionary definitions of the words "palm" and "link" are of record, in her brief "[t]he examining attorney requests that the Board take judicial notice of the dictionary definitions contained within the examining attorney's appeal brief" and which "in their printed form are attached as Exhibit A." Such request is approved inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. *See, e.g.,* *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 (TTAB 1981) at n. 7.

American Heritage Dictionary of the English Language (4th ed. 2000) defines "palm" in relevant part as "[a] unit of length equal to either the width or the length of the hand." The Examining Attorney also points out that the record contains numerous examples, of which the following are representative, of articles excerpted from the "NEXIS" database which, in pertinent part, refer to various "palm-size" radios (**emphasis added**):

"It's a cool, **palm-size** AM/FM radio that's perfect for a day at the beach." -- Dayton Daily News, January 7, 2001;

"Panasonic two-way radios are designed for keeping up with friends and family while you're shopping, hiking or anywhere on the go. The **palm-size radios** are designed to be shock and splash resistant, thanks to rubberized trim. A private talk feature allows the radio to be used as a cordless or cell phone." -- Orlando Sentinel, October 21, 2000;

"**Palm-size two-way radios** that use the new Family Radio Service wavelengths have become as basic to vacations as sunscreen and picnic baskets." -- San Francisco Chronicle, July 22, 2000;

"Whatever you want to call them, **palm-size radios** have proven popular in the United States, where families, friends and couples have embraced them for quick chats at malls, cottages or on mountain-bike trails: While easy to use, their chief benefit is no air-time or roaming fees--unlike cellphones." -- Maclean's, May 22, 2000; and

"Emboldened by a pair of \$90 **palm-size two-way radios** that would let them find each other if separated, or even call for help, they decided to strap on their skis." -- N.Y. Times, April 6, 2000.

In a similar vein, the Examining Attorney argues that the term "link" is merely descriptive of "a function of two-way

radios" because a "link" is defined, in relevant part, by an unnamed on-line dictionary as "a connector; anything that connects two or more things" and is listed by The American Heritage Dictionary of the English Language (4th ed. 2000) as meaning, *inter alia*, "**2a.** A unit in a connected series of units: *links of sausage; one link in a molecular chain.* **b.** A unit in a transportation or communications system. **c.** A connecting element; a tie or bond: *grandparents, our link with the past.*" The Examining Attorney additionally observes that the record contains several articles excerpted from the "NEXIS" database which, in pertinent part, refer to two-way radio "link(s)." The following examples are representative (**emphasis added**):

"The **two-way radio link** will allow superintendents to not only locate their equipment, but also schedule maintenance on the equipment." -- Grounds Maintenance, June 2001;

"All vehicles within the Yearsley Group incorporate the latest vehicle tracking system and a **two-way radio link** with Head Office to ensure full communication is maintained and up-to-date information can be passed on to clients." -- Frozen & Chilled Foods, March 1, 2001;

"HEADLINE: Family connections; **Two-way radios link** parents, kids" -- Atlanta Journal & Constitution, August 11, 2000;

"The \$1,500 Qualcomm Globalstar phones are tri-mode telephones, operating in both analog and digital cellular mode as well as via satellite.

They will be used to supplement **two-way radio communication links** in remote locations within the county, where cellular phone service is minimal or nonexistent" -- San Diego Union Tribune, May 5, 2000; and

"Most of what the crew knows about the race, it either hears from the **two-way radio link** in Tracy's helmet or gets in code from transmitters buried in the engine and even on each tire valve." -- St. Louis Post-Dispatch, May 30, 1999.

In view thereof, and in light of the specimen of use of applicant's mark and an advertisement for its "PalmLink™ 2-Way Family Radio Service (FRS) Radios," which is also of record, the Examining Attorney concludes that:

The evidence of record clearly shows the applicant's goods are two-way palm sized radios that provide its [sic] users with a communications link over short distances. The applicant's specimen ... shows the applicant's two-way radio to be palmed [sic] size. It fits in the palm of the user's hand. The applicant's advertisement ... shows that the two-way radio provides a communications link between two users. The ad states that it provides the "convenience of instant communications right in the palm of your hand." It touts one of the features as a "2-mile talk range," and that "they can even be used between cars that are traveling in a group." No great leaps of imagination or deep thought process or expertise is necessary to determine the descriptiveness of the applicant's mark when used with two-way radios.

We agree with applicant, however, that as stated in both its initial and reply briefs, "the PALM LINK mark clearly requires the consumer to expend imagination in order to reach any conclusion about the nature of the goods" and, therefore, it is not merely descriptive. In particular, while it is plain from the record that a significant feature or characteristic of applicant's product is that it is designed to be held in the palm of one's hand when in use and thus, like other two-way family radio service radios, is commonly described as a "palm-size"

radio, we concur with applicant that, as further pointed out in its reply brief:

There is no evidence that the word "link" by itself, which is merely used in a general sense to describe a connection, is commonly understood to refer to two-way radios in particular. The few excerpts from the Lexis/Nexis database presented by the Examining Attorney which use the word "link" in connection with two-[way] radios are not enough to establish that the word is understood as describing a feature of a two-way radio.

More importantly, even if the terms "palm" and "link" were each considered to be merely descriptive of a significant characteristic, feature, purpose, function or use of applicant's goods as contended by the Examining Attorney, "[i]t does not follow, however, that because the components of a compound mark are descriptive, ... the mark in its entirety is descriptive." *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 186 USPQ 557, 559 (TTAB 1975). Instead, the issue of whether a combination of descriptive terms is registrable depends not on the descriptiveness of the terms individually but whether the combination thereof creates a new and different commercial impression. See, e.g., *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382, 384-85 (CCPA 1968). Consequently, it is well established that otherwise descriptive terms may be combined to form a composite mark which is not merely descriptive and hence is registrable. For instance, as stated in *In re Medical Disposables Co.*, 25 USPQ2d 1801, 1804 (TTAB 1992):

[T]he mere act of combining does not in itself render the resulting composite a registrable trademark. Rather, it must be shown that in combination the descriptiveness

of the individual words has been diminished, [such] that the combination creates a term so incongruous or unusual as to possess no definitive meaning or significance other than that of an identifying mark for the goods. See *In re Calspan Technology Products, Inc.*, 197 USPQ 647 (TTAB 1977).

Here, as applicant points out in its initial brief, the combination of the terms "palm" and "link" to form its composite "PALM LINK" mark "does not identify the products being sold - two-way radios - with any degree of particularity"; instead, it creates an incongruous or unusual term which does not possess any definitive meaning as to any characteristics, functions, features, purposes or uses of applicant's goods. Specifically, it is applicant's two-way radios which are palm-sized and not, as the mark "PALM LINK" literally describes, the communications link provided by such goods. Consequently, in order for purchasers and prospective customers of applicant's two-way radios to ascribe any connotation or meaning to the mark, such as its suggesting a palm-size radio which, due to its two-way capacity, serves as a communications link, a multi-stage reasoning process or imagination is necessary.

Our conclusion that applicant's mark is suggestive rather than merely descriptive is bolstered by the fact that, as applicant notes in its main brief, "there is no evidence of others using the term 'PALM LINK' in connection with two[-]way radios." See, e.g., *In re Wells Fargo & Co.*, 231 USPQ 116, 119 (TTAB 1986) ["the absence from this record of evidence of any descriptive use of the term 'Express Savings' by others in the field of banking reinforces our view that the Examining

Attorney's mere descriptiveness holding is in error"]. None of the seven excerpts made of record by the Examining Attorney from her search in the "NEXIS" database of the composite term "palm link" indicates any third-party use of such term in relation to two-way radios.

Finally, and in any event, to the extent that there may be any doubt as to whether applicant's "PALM LINK" mark is merely descriptive or suggestive of its goods, we resolve such doubt, in accordance with the Board's practice, in favor of the publication of applicant's mark for opposition. See, e.g., In re Stroh Brewery Co., 34 USPQ 1796, 1797 (TTAB 1994); In re Morton-Norwich Products, Inc., 209 USPQ 791, 791 (TTAB 1981); and In re Gourmet Bakers, Inc., 173 USPQ 565, 565 (TTAB 1972).

Decision: The refusal under Section 2(e)(1) is reversed.